

REMARKS

Claims 3, 8, 13, 16-24, 27-30, 41-42, 44-46, 48-50, 52 and 56 are pending. By this Amendment, Claims 3, 8, 13 and 28-30 are amended, and Claims 1-2, 4-7, 9-12, 14-15, 25-26, 31-40, 43, 47, 51 and 53-55 are canceled.

Applicants gratefully acknowledged the Examiner's indication in the Office Action that Claims 27 and 56 are allowed, and that Claims 3, 8, 13 and 28-29 contain allowable subject matter.

Claims 3, 8 and 13 are amended into independent form. The dependencies of Claims 28-29 are corrected so that Claims 28-29 now depend from Claim 27.

Claim Objection

In numbered section 2 of the Office Action, the Examiner objects to Claims 28-29. Applicants respectfully submit that the amendments to Claims 28-29 obviate this objection. Withdrawal of the objection to Claims 28-29 is respectfully requested.

Claim Rejection – 35 U.S.C. § 103(a) over Nowlan & Kinoe

In numbered section 3 of the Office Action, the Examiner rejects Claims 1, 4-6, 9-10, 14-16, 30, 32-33, 37-40 and 53-55 under 35 U.S.C. § 103(a) over U.S. Patent No. 6,169,538 to Nowlan (Nowlan), in view of U.S. Patent No. 6,469,722 to Kinoe (Kinoe). This rejection is respectfully traversed.

Claims 1, 4-6, 9-10, 14-15, 32-33, 37-40 and 53-55

Claims 1, 4-6, 9-10, 14-15, 32-33, 37-40 and 53-55 are canceled, and thus their rejection is rendered moot.

Claim 16

Regarding Claim 16, Applicants note that in numbered section 5, the Examiner acknowledges that Nowlan and Kinoe each fail to disclose or suggest an

object characteristic that is a number of files in the object, as recited in Claim 16.

Accordingly, Applicants respectfully submit that the rejection of Claim 16 under 35 U.S.C. § 103(a) over Nowlan in view of Kinoe fails. Withdrawal of this rejection with respect to Claim 16 is respectfully requested. Claim 16 will be addressed in Applicants' response below to numbered section 5 of the Office Action.

Claim 30

Nowlan discloses a system wherein as a user drags a pointer across a graphical user interface keyboard, the character or key beneath the pointer is enlarged, along with characters immediately adjacent the character underneath the pointer. See for example Figures 6-7 and column 4, line 60 to column 5, line 28. If the pointer is lifted, the key beneath the pointer is accepted as a text character. See for example column 4, lines 3-5. In this way a user can compose text, as shown for example in Figure 3. The zooming feature shown in Figures 6-7 helps the user identify the character beneath the pointer, which can be useful when the un-zoomed size of the character is small and hard to see (refer to column 1, lines 12-22).

The enlargement of the character or key beneath the pointer is based on whether the user has placed the pointer over the character or key, and is not based on any characteristic of an object which the character or key represents. Accordingly, Nowlan fails to disclose or suggest *displaying said icons with different relative sizes within said window, wherein the different sizes of said icons are based upon characteristics of objects represented by the icons*, as recited in Claim 30.

Kinoe discloses a composite icon segmented into a plurality of function areas. Selecting different functions areas triggers or launches different functions. Kinoe further discloses that a user can change the size of an icon area by inputting a

numeric value via a keyboard. See, for example, Kinoe at column 3, lines 32-33 and lines 44-50.

The Examiner asserts that Kinoe at column 3, lines 44-50 teaches sizing icons differently based on characteristics of the objects that the icons represent. This assertion is respectfully traversed. This portion of Kinoe merely discloses that a user can select the size for an icon. Accordingly, Kinoe at column 3, lines 44-50 fails to disclose or suggest that different sizes of icons are based upon *characteristics of objects represented by the icons*, as recited in Claim 30.

For at least the above reasons, the asserted combination of Nowlan and Kino fails to disclose or suggest Claim 30. Withdrawal of the rejection of Claim 30 under 35 U.S.C. § 103(a) over Nowlan in view of Kinoe is respectfully requested.

Claim Rejection – 35 U.S.C. § 103(a) over Nowlan, Kinoe & Grossman

In numbered section 4 of the Office Action, the Examiner rejects Claims 2, 7, 12 and 17-18 under 35 U.S.C. § 103(a) over a combination of Nowlan, Kinoe and U.S. Patent No. 5,564,004 to Grossman, *et al.* (Grossman). This rejection is respectfully traversed.

Claims 2, 7 and 12 are canceled, and thus their rejection is rendered moot.

Regarding Claims 17-18, Grossman fails to overcome the deficiencies of Nowlan and Kinoe set forth below with respect to Claims 16, 19 and 22. Accordingly, the asserted combination of Nowlan, Kinoe and Grossman fails to disclose or suggest Claim 16, and therefore likewise fails to disclose dependent Claims 17-18 for at least the same reasons.

Withdrawal of the rejection of Claims 17-18 under 35 U.S.C. § 103(a) over the asserted combination of Nowlan, Kinoe and Grossman is respectfully requested.

Claim Rejection – 35 U.S.C. § 103(a) over Nowlan, Kinoe & Mernyk

In numbered section 5 of the Office Action, the Examiner rejects Claims 19, 22, 41 and 49 under 35 U.S.C. § 103(a) over a combination of Nowlan, Kinoe and U.S. Patent No. 6,496,206 to Mernyk, *et al.* (Mernyk). This rejection is respectfully traversed.

Mernyk is directed to a method for displaying thumbnail images of electronic files. Mernyk discloses that when an electronic folder is opened, every file in the folder is opened as a background operation and thumbnail data, such as a reduced image or text summary of the file, are derived and retained in a cache folder for quick access. When a cursor is touched, without a mouse-click, to a particular icon in the opened folder, the thumbnail for the file identified by the icon is accessed from the cache folder and displayed.

Figure 1 of Mernyk discloses an opened window, with an indication of both the number of objects in the window as well as the total size of the objects in the window.

However, Mernyk fails to disclose or suggest that the size of the window icon is based on the number of files within the window. As explained above with respect to Claim 30, Nowlan and Kinoe likewise fail to disclose or suggest sizing icons differently based on characteristics of the objects that the icons represent, for example a number of files in an object.

Nowlan, Kinoe and Mernyk each fail to disclose or suggest sizing icons differently based on characteristics of the objects that the icons represent, for example a number of files in an object.

Accordingly, the asserted combination of Nowlan, Kinoe and Mernyk fails to disclose or suggest generating icon images of different respective sizes representing objects, wherein *the size of an icon is determined by* an object characteristic wherein the object characteristic is *a number of files in the object*, as recited in Claim 16, and similar features recited in Claims 19, 22, 41 and 49.

The Examiner appears to be arguing, in essence, that if an object has a characteristic, then it would have been obvious to size an icon of the object based on the characteristic. Such an argument is incorrect. As set forth in *In re Mills*, 916 F.2d 608, 16 USPQ2d 1430 (Fed. Cir. 1990), the mere fact that references *can* be combined or modified does not render the resultant combination obvious unless the *prior art* also suggests the desirability of the combination. The Examiner has failed to show that the prior art suggests the desirability of the combination he is asserting, and has instead applied hindsight reconstruction. Accordingly, the Office Action fails to present a *prima facie* case of obviousness with respect to Claims 16, 19 and 22.

Applicants note that even if the claimed invention were within the capabilities of a person of ordinary skill in the art at the time of the invention, that is insufficient to establish a *prima facie* case of obviousness. See *Ex Parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993), and also *In re Kotzab*, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1318 (Fed. Cir. 2000). Furthermore, the Federal Circuit Court of Appeals has stated that the level of skill in the art cannot be relied upon to provide a suggestion to combine references. *Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999).

Withdrawal of the rejection of Claims 19, 22, 41 and 49 under 35 U.S.C. § 103(a) over a combination of Nowlan, Kinoe and Mernyk is respectfully requested.

Claim Rejection – 35 U.S.C. § 103(a) over Nowlan, Kinoe, Mernyk & Grossman

In numbered section 6 of the Office Action, the Examiner rejects Claims 20-21 and 23-24 under 35 U.S.C. § 103(a) over a combination of Nowlan, Kinoe, Mernyk and Grossman. This rejection is respectfully traversed.

Grossman fails to overcome the deficiencies of Nowlan, Kinoe and Mernyk set forth above with respect to allowable Claims 19 and 22. Accordingly, the asserted combination of Nowlan, Kinoe, Mernyk and Grossman fails to disclose or suggest Claims 19 and 22, and therefore likewise fails to disclose dependent Claims 20-21 and 23-24 for at least the same reasons.

Withdrawal of the rejection of Claims 20-21 and 23-24 under 35 U.S.C. § 103(a) over the asserted combination of Nowlan, Kinoe, Mernyk and Grossman is respectfully requested.

Claim Rejection – 35 U.S.C. § 103(a) over Nowlan, Kinoe, Mernyk & Simpson

In numbered section 7 of the Office Action, the Examiner rejects Claims 42, 44-46, 48-50 and 52 under 35 U.S.C. § 103(a) over a combination of Nowlan, Kinoe, Mernyk and *Windows 95 Uncut*, authored by Alan Simpson. This rejection is respectfully traversed.

Windows 95 Uncut discloses an object characteristic that is an amount of memory that the object uses. However, *Windows 95 Uncut* fails to disclose or suggest using such an object characteristic as a basis for sizing an icon of the object. Moreover, Nowlan, Kinoe, Mernyk likewise fail to disclose or suggest basing the size of an object's icon on a) an amount of memory that the object uses, b) a size of the object, or c) how recently an object was added or amended. With the benefit of hindsight it appears obvious to the Examiner to do so. However, this is insufficient to

establish a *prima facie* case of obviousness because, as stated above, the *prior art* must supply the motivation to make the changes asserted by the Examiner.

The mere fact that references *can* be combined or modified does not render the resultant combination obvious unless the *prior art* also suggests the desirability of the combination (*In re Mills*, 916 F.2d 608, 16 USPQ2d 1430 (Fed. Cir. 1990)). As stated above, even if the claimed invention were within the capabilities of a person of ordinary skill in the art at the time of the invention, that would be insufficient to establish a *prima facie* case of obviousness. *Ex Parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993), and also *In re Kotzab*, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1318 (Fed. Cir. 2000). In addition, the level of skill in the art cannot be relied upon to provide a suggestion to combine references. *AI-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999).

For at least the above reasons, the asserted combination of Nowlan, Kinoe, Mernyk and *Windows 95 Uncut* fails to disclose or suggest a) varying the size of an icon representing an object based on: a) an amount of memory the object uses (as in Claims 42, 46 and 50); b) a size of the object (as in Claims 41, 45 and 49); and c) how recently an object was added or amended (as in Claims 44, 48 and 52).

Withdrawal of the rejection of Claims 42, 44-46, 48-50 and 52 under 35 U.S.C. § 103(a) over a combination of Nowlan, Kinoe, Mernyk and *Windows 95 Uncut* is respectfully requested.

Conclusion


Applicants respectfully submit that the application is in condition for allowance. Favorable consideration on the merits and prompt allowance are respectfully requested.

In the event any questions arise regarding this communication or the application in general, the Examiner is invited to contact Applicant's undersigned representative at the telephone number listed below.

Respectfully submitted,

BURNS, DOANE, SWECKER & MATHIS, L.L.P.

Date: 01 March 2004

By: 
M. David Ream
Registration No. 35,333

P.O. Box 1404
Alexandria, Virginia 22313-1404
(703) 836-6620